

REMARKS

Remarks to follow are numbered to correspond to the office action.

Continued Examination

- 5 1. Applicant appreciates entry of the December 17, 2007 submission for continued examination.

Claims Rejections - 35 USC § 103, Response to Arguments

2-5. Applicant's claims 1-10, 12-16, 21, 23-25, 27 and 28 are
10 rejected as being obvious in light of Sonnabend and Chandler. Claims 26 and 29 are rejected based on the foregoing together with Withers, Jr. et al. All pending claims depend directly or indirectly on independent claim 1.

Following a telephone conference with Examiners Joyner and
15 McKane on April 10, 2007, applicant's independent claim 1 is amended to recite that applicant's apparatus comprises "a single, *rigid*, unitary article of fabrication, with rigidity substantially similar to that of a shot glass." As discussed in this conference, this amendment should be sufficient to overcome
20 the prior art rejections of record. However, applicant feels that these rejections cannot be sustained, even based on the unamended claims, and so enters this amendment without prejudice to any future related patent cases.

The 35 USC §103 rejection of Claim 1

As regards the 35 USC §103 rejection of claim 1, Sonnabend
“relates to a sleeve with a suction base and wall that covers,
insulates, and secures a container (column 1, lines 7-8).” More
5 concisely, in the abstract, this is described simply as “sleeve
for holding a container.” The side wall comprises “a *resilient,*
flexible, closed-cell foam made from natural or synthetic rubber
or neoprene (column 2, lines 61-62).” The base is a “*flexible*
concave base (columns 2 line 62 - column 3 line 20).” “When a
10 container is inserted in the sleeve, the container forms an
airtight fit with the wall (column 3, lines 30-32).” There is
an “orifice in the base [which] allows air to enter the sleeve
and prevents a vacuum from forming within the sleeve when the
container is removed from the base. (column 3, lines 36-38).”
15 “The orifice is formed on the enclosed wall and the wall is made
from *sufficiently flexible material to deform* under the vacuum
produced (column 3, lines 52-54).” “Neoprene is a most
preferred material for constructing the enclosed wall **2**, however
natural rubber and other synthetic rubbers can be used to form
20 the enclosed wall 2 (column 4, lines 48-51).” As relates to the
“alternate embodiments” of Figures 10 and 11, the “enclosed wall
2 is made of a *flexible material* that allows the container c to
rise in the enclosed wall when enough force is applied to the
container c to overcome the force of the vacuum. Once the
25 container is lifted above the orifice **12**, the vacuum is released

and the container can be removed easily (column 5, lines 56-61)."

Chandler discloses a beverage holder used to mount a beverage near the heating and air conditioning unit of a motor vehicle for the clearly-manifest purpose of heating or cooling the beverage. The beverage holder comprises "an inwardly turned lip . . . formed at the top of the jacket *for retaining the beverage in a stationary position* and allowing a suitable amount of spacing between the beverage and the side walls of the jacket (column 1, lines 47-51)." "Preferably, the lip **24** is sufficiently flexible to allow slight bending in order to conform to containers of different sizes and configurations (column 2, lines 58-60)." "A plurality of V-shaped indentations **38** may be formed along the distal edge of the retaining lip **24** to give it a toothed configuration *for improving flexibility and grip* (column 3, lines 20-23)." It is also clear throughout that this apparatus is not a "unitary article of fabrication" as recited in applicant's claims, nor could it be because of the required flexibility of the lip **24** on the one hand, and the required rigidity of the plastic jacket (" . . . to give the plastic jacket **20** added rigidity," column 3, lines 29-30) on the other hand.

At page 4 of the office action it is stated that a purported "inward angle" in Chandler "is provided in order [to] offer extra support . . . for a container and stabilize said container to reduce any splashes or spills. Thus, it would have

been obvious to one of ordinary skill in the art . . . to modify the apparatus of Sonnabend . . . in order [to] offer extra support . . . for a container and stabilize said container to reduce any splashes or spills as exemplified by Chandler.” This combination of references to reject applicant’s claims under 35 U.S.C. §103 does not withstand scrutiny.

In response to the recent U.S. Supreme Court decision in *KSR v. Teleflex, Inc.* (550 U.S. ___, 127 S. Ct. 1727 (2007)), the U.S. Patent and Trademark Office has issued an internal interim memorandum discussing the KSR ruling and provided guidance when considering an obviousness rejection under 35 U.S.C. §103. These guidelines state:

(1) The Court reaffirmed the Graham factors in the determination of obviousness under 35 U.S.C.

§103(a).

(2) The Court did not totally reject the use of “teaching, suggestion, or motivation” as a factor in the obviousness analysis.

(3) The Court rejected a rigid application of the “teaching, suggestion, or motivation” (TSM) test.

(4) The Court noted that the analysis supporting a rejection under 35 U.S.C. §103(a) should be made explicit, and that it was “important to identify a reason that would have prompted a person of ordinary

skill in the relevant field to combine the [prior art] elements" in the manner claimed.

Additionally, the court in KSR stated that when considering obviousness of a combination of known elements, the operative question is "whether the improvement is more than the predictable use of prior art elements *according to their established functions.*" (emphasis added)

First, there is nothing in either Sonnabend or Chandler which teaches or suggests or motivates adding to Sonnabend, an "inward angle . . . greater than zero degrees at said open top" as claimed by applicant. While applicant's claims in question are apparatus claims, these cannot be viewed without considering the function supported by means of this apparatus, with all elements of the apparatus taken in combination "as a whole," and absent impermissible hindsight.

Each of Sonnabend and Chandler is designed to hold a beverage container, and in the case of Chandler, the primary motivation is to heat or cool the container and its contents using the heating and air conditioning unit of a motor vehicle by providing a suitable space for air to circulate. In Sonnabend, the apparatus is a simply a sleeve to firmly hold the container in an upright position, and there is no motivation to provide any "air space" between the container and the sleeve.

In fact, the emphasis that the "container forms an airtight fit with the wall" (column 3, lines 30-32) teaches away from a combination with Chandler, because leaving an airspace as in Chandler would destabilize the container.

5 In Chandler, the objective is to heat or cool the container, and to do so, there needs to be an air space between the sleeve and the container to permit the circulation of heated or cooled air from the heating and air conditioning unit of the motor vehicle. To compensate for the reduction in stability
10 caused by this air space, a lip **24** is provided which presses against the outside of the container for stability, and any "inward" angling of this lip is used to provide the air circulation space between the container and the jacket **20** while at the same time maintaining stability of the container.

15 As regards obviousness, KSR states that the operative question is "whether the improvement is more than the predictable use of prior art elements according to their established functions." The flexible lip **24** in Chandler serves the prior art function of holding the beverage container upright
20 while maintaining an air space for heating and cooling. The "inward angle" in applicant's apparatus serves the distinct function of preventing splashing of the surgical fluid contained directly within applicant's apparatus without an intermediating container. That is, the lip in Chandler, serves a totally

different "established function" than the inward angle of applicant's claims, and applicant is not using the inward angle according to its established prior art function from Chandler.

(It should also be noted that the alternative embodiment of Chandler's Figure 8, which entirely foregoes the jacket **20** in favor of a "gridlike" jacket **20B**, makes clear that the jacket need not be capable of itself holding a fluid as does applicant's invention. The objective in Chandler is to facilitate air flow for heating and cooling, and it would be impossible to use this embodiment to hold a fluid absent the separate beverage container. The same point is underscored by the orifice **12** in the alternative embodiments in Sonnabend's Figures 10 and 11 which permits air flow as the container is inserted into and removed from the apparatus, but would render it impossible for the apparatus to contain a fluid.)

Further, because the object of Chandler is to hold the container in place near the heating and air conditioning unit of the motor vehicle, it is necessary that this apparatus be mounted to the heating and air conditioning unit, see the hooked ends **23** used for mounting and also Figure 8. There is no motivation to place Chandler's device atop a flat surface, and therefore, there would be no motivation whatsoever to add the "base" features of Sonnabend to the apparatus of Chandler.

In sum, there is no teaching, suggestion, or motivation to

add the "top portion" of Chandler's device to the "bottom portion" of Sonnabend's device, and there is no teaching, suggestion, or motivation to add the "bottom portion" of Sonnabend's device to the "top portion" of Chandler's device.

5 Further, Sonnabend teaches away from this combination because of the premium it places on an "airtight fit," and Chandler teaches away from this combination because its whole *raison d'être* is to heat or cool the beverage by mounting on the heating and air conditioning unit (see the hooked ends **23** and the hooks in
10 Figure 8). So adding any sort of base to Chandler along the lines of Sonnabend's is totally superfluous and irrelevant. By trying to combine Sonnabend and Chandler, examiner is applying impermissible hindsight without any teaching, suggestion or motivation from either reference.

15 Additionally, examiner has not been able to "identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements." The reason given by examiner is to "offer extra support . . . for a container and stabilize said container to reduce any splashes or
20 spills as exemplified by Chandler." However, Sonnabend is perfectly acceptable as is, because it provides an airtight fit with the container, and there is no reason to add an airspace and then be forced to add a lip to compensate for the airspace. In fact, adding an airspace reduces support and teaches away

from Sonnabend's motivation. Chandler, on the other hand, by virtue of its hooked mounting to the heating and air conditioning unit, already provides the stability otherwise provided by the vacuum base of Sonnabend, and so there is no reason for a combination from this perspective either. Thus, the reason offered simply cannot be supported.

To use the language of KSR, applicant's invention, taken in combination and as a whole, is "more than the predictable use of prior art elements according to their established functions."

And further, as already stated, the use of the "lip" in Chandler serves an "established function" which cannot even be analogized in the first place to the function of the inward angle in applicant's apparatus.

For all of the foregoing reasons, the rejection under 35 U.S.C. § 103 is improper and cannot be sustained, *even absent the claims amendments which have been entered with his reply.* We now examine how these amendments provide additional support for patentability.

Claims Amendments

Applicant's disclosure provides ample support for the amended claim recitation of a "rigid, unitary article of fabrication, with rigidity substantially similar to that of a shot glass."

MPEP section 2163.07(a), titled Inherent Function, Theory, or Advantage, states that:

By disclosing in a patent application a device that inherently performs a function or has a property, operates according to a theory or has an advantage, a patent application necessarily discloses that function, theory or advantage, even though it says nothing explicit concerning it. The application may later be amended to recite the function, theory or advantage without introducing prohibited new matter.

In re Reynolds, 443 F.2d 384, 170 USPQ 94 (CCPA 1971); *In re Smythe*, 480 F. 2d 1376, 178 USPQ 279 (CCPA 1973). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted).

Throughout applicant's disclosure, it is made clear that applicant's device is to be very similar in its material

characteristics to that of a "shot glass," but for the problems with the way in which a shot glass is physically dimensioned and thereby subject to tipping and splashing. This, together with the requirement that applicant's apparatus comprises "a single,
5 unitary article of fabrication," is discussed throughout the disclosure, see, for example, paragraphs 3-5, 12-13, 28-29, 32, 35, 39 and 43, as well as the originally-filed claims, of applicant's pre-grant publication US 2004/0011695.

While applicant's disclosure "says nothing explicit" about
10 "rigidity" per se, this is inherent in applicant's disclosure through the many references which make clear that the goal is to provide a fluid-holding device that is very similar in character to a shot glass, but for the spatial configuration which makes a shot glass prone to tipping and splashing. The amended claim
15 recitation "rigidity substantially similar to that of a shot glass" ensures that the claim recitation is tied directly to the repeated comparisons which applicant's disclosure makes to a shot glass, and therefore cannot be read, for example, on a flexible plasticized or rubberized apparatus such as is
20 disclosed by both of Sonnabend and Chandler.

Given this claim amendment, the apparatus of Chandler - once an air space is provided - requires that the compensating lip be "flexible . . . in order to conform to containers of different sizes and configurations (column 2, lines 58-60)."

This is understandable because both Sonnabend and Chandler provide a means for holding a beverage container, and some flexibility is required to move the container into and out from the sleeve which is used for its retention. But applicant's
5 apparatus serves no such function and requires no such flexibility. Applicant's device is a means for directly containing a surgical fluid while being rested upon a surgical table. Applicant's device is not in any way intended as a means for holding a separate container. Therefore, the rigid material
10 composition akin to that of a shot glass as now claimed, would not be suitable for use in either Sonnabend or Chandler, each of which teaches away from such a rigid material by virtue of their being used as means for holding a beverage container. This is in stark contrast to applicant's apparatus which is a means for
15 directly containing a surgical fluid in a stable manner without tipping or splashing, and for which the inward angle serves an entirely different function than Candler's lip.

For all the foregoing reasons, and in light of this amendment, all rejections of record have been overcome with
20 respect to independent claim 1, which is now allowable over all art of record. Because all remaining pending claims are dependent on claim 1, these too should be allowed at this time, on the basis of this dependency, and also, on the basis of the further points of patentable distinctness which need not be

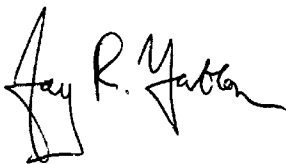
addressed in this reply.

Conclusion

7. As a result of the foregoing, applicant respectfully
5 requests entry of the amendments herein without prejudice to
future patent cases. Applicant further requests a finding of
record that the claims and arguments presented overcome all
rejections to date. Finally, applicant requests and looks
forward to a notice of allowance in the near future.

10 As noted earlier, if these amendments and remarks do not
place this application into condition for allowance, applicants'
counsel hereby respectfully requests a telephone interview with
examiner Kevin Joyner, following receipt of this reply, and
prior to issuance of any further office action.

15 Respectfully submitted,

A handwritten signature in black ink, appearing to read "Jay R. Yablon". The signature is stylized with a large, looped initial "J" and a cursive "Yablon".

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